

REMARKS

Please reconsider the application in view of the above amendments and the following remarks. Applicant thanks the Examiner for carefully considering this application.

Disposition of Claims

Claims 1-25 were pending in the referenced application. Claims 2-4, 6-7, 9-20, 23, and 25 have been cancelled by the reply, without prejudice or disclaimer. Further, new claims 26-32 have been added by this reply. With respect to the remaining claims, claims 1 and 21 are independent and the remaining dependent claims depend, directly or indirectly on claims 1 and 21.

Claim Amendments

Claims 1, 5, 21, and 22 have been amended by this reply to clarify the claimed invention. Support for these amendments may be found, for example, in paragraphs [0001], [0025], [0029], and [0030] as well as Figures 2-4. No new matter has been added by any of the aforementioned amendments.

Drawings

Applicant thanks the Examiner for indicating that the drawings filed on November 14, 2003, are accepted.

Information Disclosure Statement (IDS)

Applicant thanks the Examiner for initialing the (IDS) filed on February 23, 2004.

Rejection Under 35 U.S.C. § 101

Claims 1, 3-9, 11, 13-17, 19, 21, and 23-35 stand rejected under 35 U.S.C. § 101. Claims 4, 6, 7, 11, 13-17, 23 and 25 have been cancelled by this reply. Accordingly, this rejection is now moot with respect to the cancelled claims. To the extent the rejection applies to the pending claims, the rejection is respectfully traversed.

Independent claims 1 and 21, as amended, are now directed to a method and computer system, respectively, which produce useful and tangible results. Specifically, the independent claims have been amended to recite:

parsing the object file, by a tracing framework, to
enable the probe in the program;
tracing the program, wherein tracing the program
comprising encountering the probe;
executing at least one selected from a group consisting
of the pre-defined action and the action
associated with the probe to obtain data

Applicant asserts that enabling a probe in a program, tracing the program, and obtaining data based on the tracing of the program provides a useful and tangible result. As discussed in the specification, the tracing of a program allows a user to record data at locations of interest during the execution of the program. The recorded data may then be used by the user to understand the internal operation of the program. (*See e.g.*, Referenced Application [0001] and [0002]).

In view of the above, amended independent claims 1 and 21 satisfy the requirements under 35 U.S.C. § 101. Dependent claims satisfy 35 U.S.C. § 101 for at least the same reasons as amended independent claims 1 and 21.

Rejection Under 35 U.S.C. § 103

Claims 1, 3, 4, 13, 21, 24, and 25 stand rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Patent Application Publication No. 2002/0095660 ("O'Brien") in view of U.S. Patent No. 6,678,883 ("Berry"). Claims 4, 13, and 25 have been cancelled by this reply. Accordingly, this rejection is now moot with respect to those claims. To the extent that this rejection applies to the amended claims, the rejection is respectfully traversed.

In order to establish a *prima facie* case of obviousness, the cited references must teach or suggest all the limitations of the claims. *See* MPEP § 2143. Applicant asserts that the cited references fail to teach or suggest at least the following limitations of amended independent claims 1 and 21:

parsing the object file, by a tracing framework, to
enable the probe in the program;
tracing the program, wherein tracing the program
comprising encountering the probe;
executing at least one selected from a group consisting
of the pre-defined action and the action
associated with the probe to obtain data

The Examiner has admitted that O'Brien fails to disclose an object file. *See* Office Action mailed February 8, 2007, p. 3. Further, Berry fails to teach or suggest that which O'Brien lacks. Specifically, the Examiner has asserted that the symbol file taught by Berry is equivalent to the object file recited in the claims. *See* Office Action mailed February 8, 2007, pp. 3-4. Applicant disagrees. The symbol file taught in Berry is generated from the results of tracing. Said another way, the output obtained from the tracing is used to generate the symbol file. *See e.g.*, Berry, Figure 14. In contrast, the object file recited in the claims is used to enable a probe in a program and further defines an action (or pre-defined action) to execute when the enabled probe is encountered

during the tracing of the program. Thus, the object file recited in the claims is used to enable the tracing to occur, while the symbol file corresponds to data generated from the tracing. In view of this, the symbol file cannot be properly equated to the object file recited in the amended independent claims.

In view of the above, amended independent claims 1 and 21 are patentable over O'Brien and Berry, whether considered separately or in combination. Dependent claims are patentable over O'Brien and Berry for at least the same reasons as the aforementioned independent claim. Accordingly, withdrawal of this rejection is respectfully requested.

Claims 2, 5-12, 14-20, 22, and 23 stand rejected under 35 U.S.C. § 103 as being unpatentable over O'Brien in view of Berry and the article entitled "Performance Profiling Using TNF" ("Murayama"). Claims 2, 6-7, 9-12, 14-20, and 23 have been cancelled by this reply. Accordingly, this rejection is now moot with respect to those claims. To the extent that this rejection applies to the amended claims, the rejection is respectfully traversed.

With respect to the remaining pending claims addressed in this rejection, claim 8 depends from claim 1 and claim 22 depends from claim 21. As discussed above, O'Brien and Berry fail to teach or suggest the invention as recited in amended independent claims 1 and 21. Further, Murayama does not teach or suggest an object file or using an object file for the purpose of tracing a program as recited in amended independent claims 1 and 21.

In view of the above, amended independent claims 1 and 21 are patentable over O'Brien, Berry and Murayama, whether considered separately or in combination. Dependent claims 8 and 22 are patentable over O'Brien, Berry, and Murayama for at least the same reasons as the

aforementioned independent claim. Accordingly, withdrawal of this rejection is respectfully requested.

New Claims

New claims 26-32 have been added by this reply. Support for the new claims may be found, for example, in original claim 5, paragraphs [0025], [0030], and Figures 2-4 of the referenced application. No new matter has been added by any of the new claims. New claims 26-29 depend, directly or indirectly, on amended independent claim 21 and, accordingly, are patentable over the cited references for at least the same reasons as amended independent claim 21. New claims 30-32 depend, directly or indirectly, on amended independent claim 1 and, accordingly, are patentable over the cited references for at least the same reasons as amended independent claim 1.


In view of the above, favorable action in the form of a Notice of Allowability is respectfully requested for the new claims.

Conclusion

Applicant believes this reply is fully responsive to all outstanding issues and places this application in condition for allowance. If this belief is incorrect, or other issues arise, the Examiner is encouraged to contact the undersigned or his associates at the telephone number listed below. Please apply any charges not covered, or any credits, to Deposit Account 50-0591 (Reference Number 03226/345001).

Dated: May 4, 2007

Respectfully submitted,

By  ^{#20031} ~~ALY DOSSA~~

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Amendment (11 pages)
Amendment Transmittal (1 page)